



INTELLECTUAL PROPERTY LAW
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December 1, 2009

By Email

Marcus E. Sernel, Esq.
Kirkland & Ellis LLP
200 East Randolph Drive
Chicago, IL 60601

**Re: Centocor Ortho Biotech, Inc. v. Genentech, Inc. et al.,
Case No. 08-cv-03573, C.D. Cal.**

Dear Marc:

I am writing to identify certain of the deficiencies in Genentech's document production to date (under the "GENE CEN" and "GNE MED" bates prefixes), itemized below. Please confirm that you will be providing the following documents forthwith:

1. Cabilly family prosecution file histories

You have not produced file histories for the US divisional and continuation applications of the Cabilly II application, *i.e.* applications Ser. Nos. 08/909,611; 08/422,187; and 08/931,121.

These documents are responsive to at least Centocor's requests nos. 26, 27, 28, and 32.

**2. All transcripts and exhibits from the *MedImmune v. Genentech* litigation,
Civ. A. No. 2:03-cv-02567**

You have not produced all, but rather only some, of the deposition transcripts and exhibits from the *MedImmune* litigation. For instance, the transcripts and exhibits from the 2007 depositions of Ian Armitage, Ginger Dreger, Max Hensley, and Sean Johnston have not been produced (*see* GENE-CEN 002199). Please produce all such transcripts and exhibits.



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These documents are responsive to at least Centocor's requests nos. 72, 74, 77, and 82.

**3. All pleadings and exhibits from *Cabilly v. Glaxo Wellcome*,
Interference No. 104,532**

You have not produced a complete set of exhibits submitted to the Board of Patent Appeals and Interferences during the *Cabilly v. Glaxo Wellcome* interference, but rather only selected exhibits. Please produce all such exhibits.

These documents are responsive to at least Centocor's requests nos. 30-32, 64.

**4. All pleadings, transcripts, and exhibits from the *Chiron v. Genentech* litigation,
Civ. A. No. 2:00-cv-1252**

You have not produced all pleadings, trial transcripts, trial exhibits, expert reports, deposition transcripts, and deposition exhibits from the *Chiron* litigation, including the appeal. Specifically, you have not produced the briefing and appendices from the appeal (docket nos. 03-1158, 03-1159, reported at *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247 (2004)).

These documents are responsive to at least Centocor's requests nos. 83, 85, 88, and 93. They are also particularly relevant to the section 112 issues in this case in light of, for instance, the positions that Genentech and its experts took on the historic state of antibody technology. *See, e.g., Chiron*, 363 F.3d at 1256 ("In particular, Genentech's expert, Dr. French, testified that making chimeric antibodies was not routine technology in 1985 or 1986. Dr. French also testified that, by 1986, only a few laboratories had the capacity and expertise necessary to make genetically engineered antibodies.").

**5. Drafts of written submissions, expert reports, declarations, and other written
statements provided to US and European patent authorities**

You have not produced any drafts of the written submissions, expert reports, declarations, and other written statements that were submitted to the patent authorities during (i) the prosecution of the Cabilly family of patents, (ii) the merged reexamination of the Cabilly II patent, or (iii) the EP opposition proceeding EP-B-0120694. Nor have you supplied a privilege log explaining the basis for withholding any such drafts. Please either confirm that no such drafts exist, or that you will be producing them and/or providing a privilege log forthwith.

These documents are responsive to at least Centocor's requests nos. 3, 4, 23, 24, 30, 31, and 32, 56 and 57, 66 and 67.



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6. Design, structure, function, and operation of alleged embodiments of Cabilly II

You have not produced documents demonstrating the design, structure, function, and operation of the biologics or other products that you contend embody the invention of the Cabilly II patent, including the five commercial products (Herceptin, Avastin, Xolair, Rituxan, and Raptiva) that you identified in response to Centocor's interrogatory no. 4.

These documents are responsive to at least Centocor's request no. 94.

7. First public use, first public disclosure, first manufacture, first offer of sale, and first sale of alleged embodiments of Cabilly II

You have not produced documents demonstrating the first public use, first public disclosure, first manufacture, first offer of sale, and first sale of the biologics or other products that you contend embody the invention of the Cabilly II patent, including the five commercial products (Herceptin, Avastin, Xolair, Rituxan, and Raptiva) that you identified in response to Centocor's interrogatory no. 4.

These documents are responsive to at least Centocor's requests nos. 95, 96, and 102.

8. All Cabilly license agreements and expert reports relating to same

You have not produced all of the license agreements to the Cabilly patent family. We are aware of at least 58 such licenses. Additionally, the only copy of the expert report of E. Fintan Walton, from the *MedImmune* litigation, that you have provided is missing the appendix 3 summary of Cabilly license agreements. Please produce a complete copy of Mr. Walton's report, with all appendices, as well as all other previously prepared expert reports relating to license agreements to the Cabilly patent family. And please produce all license agreement relating to the Cabilly patent family, including all agreements listed in Mr. Walton's report.

These documents are responsive to at least Centocor's requests nos. 17, 18, and 20.

9. Technical documents relating to the development of the invention of the Basey '335 Patent.

You have not produced any of the technical documents, such as laboratory notebooks or technical memoranda or reports, relating to the development, conception, or reduction to practice of the purported invention claimed in the Basey '335 Patent.



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These documents are responsive to at least Centocor's requests nos. 128, 129, and 130.

10. Design, structure, function, and operation of alleged embodiments of the Basey '335 Patent

You have not produced documents demonstrating the design, structure, function, and operation of each Genentech product, apparatus, and/or process that you believe embodies, incorporates, or uses any alleged invention of the '335 Patent, including Herceptin which was identified in response to Centocor's interrogatory no. 4.

These documents are responsive to at least Centocor's request no. 119.

11. All Basey '335 Patent license agreements

We have not identified any license agreements related to the '335 Patent. Please either confirm that no such licenses exist, or that you will be producing them forthwith.

These documents are responsive to at least Centocor's request no. 115.

* * *

We look forward to your prompt response and production of the above categories of documents as well as all other documents subsumed by Centocor's requests. Please confirm by the end of business this Friday, December 4, that these documents will be produced. As always, please feel free to call or contact me should you have any questions or wish to discuss matters further.

Sincerely yours,

A handwritten signature in black ink, appearing to read 'Alex J. Goranin'.

Alex Goranin



Marcus E. Sernel, Esq.

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cc: David I. Gindler, Esq. (coh.centocor.team@irell.com)
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